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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/706,382 11/06/00 LIN

J

EXAMINER

QM22/0628

J T LIN
4532 OLD CARRIAGE TRAIL
OVIEDO FL 32765

BURD. D

ART UNIT

PAPER NUMBER

3739

DATE MAILED:

06/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/706,382

Applicant(s)

LIN, J. T.

Examiner

David Burd

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 21 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Objections

Specification

If applicant continues to prosecute the application, revision of the specification and claims to present the application in non-ambiguous language is required. While an application can be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed.

The disclosure is objected to because term "corneal" is mistakenly used on page 5, lines 11, 12, 16, and 32, and the term "cornea" is mistakenly used on page 6, line 13. In all these instances, it is now clear that the word "scleral" or "sclera" would have been appropriate and correct in place of the words "corneal" and "cornea."

Claims

Claim 1 is objected to as the first two lines recite "a portion of the corneal sclera tissue is removed by steps of" which is not possible as the two tissues are separate and distinct. The word "corneal" should be deleted.

Additionally, step (c) of claim 1 recites "on the corneal surface to remove part of the sclera tissue" which is incorrect for the same reason. The word "corneal" should be replaced with - scleral -- .

Claim 2 recites "200 nenoseconds." This should read - 200 nanoseconds --.

Claim 7 recites "higher than 2 Walt." This should read - higher than 2 watts -- .

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Claim 7, line 3 recites "on the cornea surface." This should read -- on the sclera surface -- .

Appropriate correction is required.

The Examiner will, however, examine the disclosure on its merits with the above corrections being incorporated.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to base claim 1, lines 1-2 of the preamble confusingly recite "a portion of the corneal sclera tissue;" furthermore, the term "corneal surface" on line 7 is incompatible with the term "sclera tissue" on line 8. It is noted that both of these terminology errors are addressed in the above Objections to the specification and claims.

Claim 1 recites the limitation "the corneal sclera tissue" in line 1 of the preamble. There is insufficient antecedent basis for this limitation in the claim.

Claim 1, step (c), line 2, recites "the corneal surface." There is insufficient antecedent basis for this limitation in the claim. The last line of step (c) recites the limitation "the corneal lens." There is insufficient antecedent basis for this limitation in the claim.

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Claim 7, line 3 recites the term "the cornea surface." There is insufficient antecedent basis for this limitation in the claim.

Dependent claims 2-6, 8-20 are accordingly rejected.

Response to Amendment

Applicant's amendment #8/A of June 7, 2001, was entered June 11, and is acknowledged.

The specification and claims of the original filing, and amendment #8/A, contain contradictory language that has caused confusion as to the invention on its merits. The terms "sclera" and "cornea" have been mistakenly interchanged in claim 1, and also in other places in the claims and specification as noted above in the Objections to the specification and the claims.

The Examiner's first Office Action addressed primarily laser treatment of the cornea. It is now clear from Applicant's amendment that his laser treatment is solely applied to the portion of the eye defined as the sclera, which is the opaque outer layer white portion of the eye *outside* of the cornea, and not the clear cornea itself which is the outer layer of the eye that is over the iris and pupil, and through which light passes.

It is acknowledged that claims 21 and 22 have canceled by the Applicant.

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Response to Arguments

Applicant's arguments made it clear that his method was a pattern of laser energy applied so as to be treating the sclera portion of the eye, and not the cornea. This Office Action examines the invention thusly.

Allowable Subject Matter

Claims 1-20 are rejected as recited in the above 35 U.S.C. 112 rejection, but would be allowable if rewritten to overcome the terminology contradictions and the 35 U.S.C. #112 rejections as cited above. Applicant's corrections of the specification and claims must have no ambiguity regarding the terms sclera and cornea.

Reasons for Allowance

The following is an examiner's statement of reasons for allowance: Latina (5,152,760), Schachar (6,197,056 B1 and 5,722,952), and O'Donnell, Jr. (5,549,598) are representative of treatment pertaining to the sclera of the eye. Latina discloses selective laser ablation of the sclera to treat glaucoma, while Schachar discloses mechanical devices implanted or attached to the sclera for treating presbyopia, and O'Donnell, Jr. discloses cutting of the sclera. None of the prior art fairly discloses or suggests Applicant's precise method of applying patterns of laser energy to allow further accommodation for the eye's lens held behind the eye's cornea.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

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accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

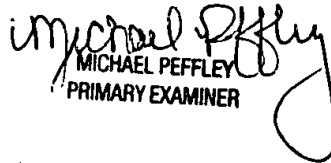
Conclusion

Any inquiry concerning the communication from the examiner should be directed to David Burd whose telephone number is (703) 305-0910. The examiner can normally be reached Monday - Friday from 9 am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Ms. Linda Dvorak, can be reached on (703) 308-0994. The Fax number for this Group is (703) 305-3590.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0858.

Dmb
June 26, 2001


MICHAEL PEFFLEY
PRIMARY EXAMINER